

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Bradford

Appeal No. _____
Application No. 10/629,726

AMENDED APPEAL BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Judson A. Bradford Art Unit: 3727
Serial No.: 10/629,726 Examiner: Eugene Lhynn
Filed: July 29, 2003 Atty. Docket No.: BRP-200
For: COMBINATION OF PARTITION ASSEMBLY AND CONTAINER AND
METHOD OF USE

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDED APPEAL BRIEF

J. REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee, Bradford Company, 13500 Quincy Street, P.O. Box 1199, Holland, Michigan 49422-1199.

J. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III STATUS OF CLAIMS

Claims 1-13 and 21-33 are pending in the application. All pending claims stand rejected, and are now on appeal. Claims 14-20 have been cancelled.

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is generally directed to a combination 10 comprising a partition assembly 14 including intersecting slotted partitions 16, 18 arranged in an assembly or matrix 14 and a container 12. See specification, page 6, lines 8-10. The container 12 has walls 36, 38 extending upwardly from a bottom 34. The walls 36, 38 and bottom 34 of the container 12 define an interior 40 of the container 12. See Fig. 1 and specification, page 7, lines 16-18. The partitions or dividers 16, 18 are of a length such that the partition assembly 14 may fit inside the interior 40 of the container 12 without bending the partitions 16, 18. See specification, page 5, lines 1-6 and Fig. 2. The partition assembly 14 is held in the interior 40 of the container 12 by at least one hook and loop fastener 52 in a manner shown in Fig. 2. See specification, page 8, lines 8-10.

The combination 10 comprises a container 12 and a partition assembly 14 for dividing space inside the container 12. The container 12 has a plurality of walls 36, 38. One component 54 of a two part hook and loop fastener 52 is secured to an inner surface of one of the container walls 36, 38. See specification, page 8, lines 21-28. The partition assembly 14 comprises a plurality of first slotted partitions 16, a plurality of second slotted partitions 18 arranged intersecting with each other at intersections 19 to form a partition assembly or matrix 14. See specification, page 6, lines 11-15 and Fig. 1. One of the slotted partitions 16, 18 has a flexible tab at the end thereof. The flexible tab comprises a second component 56 of the two part hook and loop fastener 52 adapted for engagement with the first component 54 of the two part hook and loop fastener 52 without bending any of the partitions 16, 18. The tab may be bent to

either side of the slotted partition to engage the first component 54 of the two part hook and loop fastener 52. See specification, page 9, lines 1-12 and Fig. 2.

As recited in independent claim 12, the linear distance between the inner surfaces 42 of the side walls 36 of container 12 defines the width W of the interior 40 of the container 12. Similarly, the linear distance between the inner surfaces 46 of the end walls 38 of container 12 defines the length L of the interior 40 of the container 12. See specification, page 7, lines 16-25 and Fig. 2. See specification, page 7, lines 16-25 and Fig. 2. Also, each first slotted partition 16 has a series of slots extending inwardly from a top edge 20 thereof. Each second slotted partition 18 has a series of slots extending inwardly from a bottom edge 28 thereof. See specification, page 6, line 25 to page 7, line 15. The first and second partitions 16, 18 are arranged in a matrix 14, one of the slots of a first slotted partition 16 being engaged with one of the slots of a second slotted partition 18 at an intersection 19. See specification, page 6, lines 11-15. Each of the first slotted partitions 16 is shorter than the width W of the interior 40 of the container 12 and each of the second slotted partitions 18 is shorter than the length L of the interior 40 of the container 12. See specification, page 5, lines 1-7 and Fig. 2.

As recited in independent claim 21, the second flexible component 56 of the hook and loop fastener 52 is secured to one of the partitions 16, 18 and is adapted to bend both clockwise and counterclockwise relative to the partition. See specification, page 5, lines 19-25 and Fig. 2.

As recited in independent claim 28, the flexible tab comprising the second component 56 of the hook and loop fastener 52 is sandwiched around the end of one of the partitions 16, 18 and is adapted for engagement with the first component of the two part hook

and loop fastener without bending any of the partitions. See specification, page 9, lines 1-12 and Fig. 1.

In one embodiment, a first component 54 of each hook and loop fastener 52 is secured to an inside surface 46 of either a side wall 36 or an end wall 38 of the container 12. The first component 54 of each hook and loop fastener 52 has an outer surface 58 which is either hooks or loops of a conventional Velcro® hook and loop fastener arrangement which is adapted to engage an outer surface 60 of the second component 56. The second component 56 of the hook and loop fastener 52 comprises in one embodiment a flexible tab made from two pieces of fabric 62. Each piece of fabric 62 has an outer surface 64 covered with either hooks or loops and an inner surface 66 covered with adhesive such that the two pieces of fabric 62 may be secured to opposite sides of the end or outer portion 68 of one of the individual partitions 16, 18 of the partition assembly 14. See Fig. 1.

In another embodiment of the invention (see Fig. 1A), the second component 56' of the hook and loop fastener 52 comprises a single piece of folded flexible fabric material having an outer surface 70 covered with either hooks or loops and an inner surface 72 covered with adhesive. Upon removal of a backing material 74, one end portion 76 of the component 56' is adhesively secured to one side surface 78 of a partition 80 and a second end portion 82 of the component 56' is adhesively secured to a second side surface 84 of the partition 80.

In prior art practice where slotted partition assemblies were to be attached to a container inside the container, the practice was to bend individual partitions and attach the bent portion or portions of the partition or partitions to the inside surface of the container as, for example, by stapling or gluing a folded end portion of the divider to the inside surface of the

container. But this meant that all of the partitions which are generally automatically manufactured and assembled on a machine must include extra partition material and generally must be fixedly secured to the inside of the container rather than being removably secured as is the case of the invention of this application. Furthermore, the dimensions of the containers sometimes vary as does the dimension of the dividers or partitions. By utilizing flexible hook and loop type tabs on the ends of selected partitions and securing them to Velcro® hook and loop components on the inside of the container, varying sizes of dividers may be secured to varying sizes of containers. Such use therefore accommodates dimensional variances commonly encountered in the production of containers and/or slotted partition assemblies. And, of course, the use of Velcro®-type hook and loop connector components to secure the partition assembly to the inside of the container enables the assembly to be removably secured and used in one or more containers of the same or differing dimensions.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-3, 6-10, 12, 21, 23, 26-28, 31 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,403,638 (hereinafter *Baum*) in view of U.S. Patent No. 5,069,514 (hereinafter *Sherman*).

Claims 4, 5, 9, 11, 13, 22, 24, 25 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Baum* in view of *Sherman* as applied to claim 1, and in further view of U.S. Patent No. 4,610,286 (hereinafter *Cyr*).

Claims 30 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Baum* in view of *Sherman* as applied to claim 1, and in further view of U.S. Patent No. 6,535,606 (hereinafter *Cox*).

VII. ARGUMENT

Rejection of Claims 1-3, 6-10, 12, 21, 23, 26-28, 31 and 33 Under 35 U.S.C. § 103(a)

Claims 1-3, 6-10, 12, 21, 23, 26-28, 31, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Baum* in view of *Sherman*. The Examiner contends that *Baum* discloses a partition assembly (Fig. 4), a container having walls extending upwardly from a bottom, defining an interior of a container (Fig. 4, item 23), partitions being of a length such that they do not bend when inserted (Fig. 4) wherein the partition assembly is held in the interior of the container by at least one hook and loop fastener (Fig. 4, item 32).

The Examiner correctly states in the final Office Action that *Baum* fails to teach slotted intersecting partitions which form a matrix. *Baum* fails to disclose teach or suggest a partition assembly. Instead *Baum* discloses individual partitions 34, 35 which are movable inside an insert assembly 22. See Fig. 4 of *Baum*. *Baum* discloses a two substantially identical individually usable camera bags 11a and 11b attached together by a zipper or slide assembly 12. See Fig. 1 of *Baum*. As best illustrated in Figs. 4, 6 and 7 of *Baum*, there is an insert assembly 22 in the form of a container 23 which is to be received within one of the camera bags 11a. See Fig. 3 of *Baum*. It is this insert assembly 22 upon which the Examiner relies in connection with his rejection of the claims of this application. The insert assembly 22 comprises a container portion 23 shown in Fig. 6 of *Baum* comprising a bottom wall 24, side walls 25, 26, end walls 27, 28 and

a top wall or closure flap 29, all integrally formed of a semi-rigid panel 41 of cardboard covered on both sides by a layer of foam cushion material 42. See Column 2, lines 60-66 of *Baum*. The two layers of foam 42 are covered by a fabric covering 30, 31 sewn together at the lines of juncture as best illustrated in Fig. 7 of *Baum*. When folded from the flat configuration illustrated in Fig. 6 to the container configuration illustrated in Fig. 4, the insert assembly 22 results in a container having a bottom wall 24, a front wall 25, a rear wall 26 from which side walls 27 and 28 extend, and a top wall or lid 29. The lid 29 in turn has Velcro® hook strips or burr strips 33 extending therefrom and engageable with the fabric covering of the front wall 25 to hold the lid or top panel 29 in a closed position.

Additionally, according to the disclosure of *Baum*, there are two adjustable interior partitions 34, 35 which are fabricated of the same materials as the container portion 23 (cardboard center ply, two covering foam plies and sandwiched between fabric plies) (see column 3, lines 25-28). The fabric covering layers 30, 31 at the inside and outside respectively of the container portion 23 and the partition members 34, 35 "are of a soft, fine, wool-like material to which the miniature hooks or burrs of pressure sensitive Velcro® strips will adhere" (Column 3, lines 7-11). As best illustrated in Fig. 4 of *Baum*, the longitudinal edges of the partition wall 34, 35 have sewn thereto in spaced relation along each side Velcro® hook or burr strips 36, 37, 38 and 39 which are used to releasably secure the partition walls in any desired position between the inner surfaces of the container portion 23. It is important to note at this point that the Velcro® hook or burr strips 36, 37, 38 and 39 are sewn to the partition walls and extend at right angles to the walls. They clearly do not extend in the same direction as the partition walls and form extensions of those walls.

Sherman discloses a storage device for storing pantyhose in a dresser drawer. The pantyhose storage device comprises a partition assembly manufactured from first and second sets of orthogonally oriented slotted partitions, which partitions of first and second slots are slotted from opposite sides of the top and bottom edges so that when mated, the two sets of partitions form a matrix of cells for receiving folded pantyhose within each cell. There is no disclosure of this patent of any mechanism or means for attaching or securing this matrix of slotted partitions within a dresser drawer or any form of container.

The Examiner states in the final Office Action that with regards to claims 1-3, 6-10, 12, 21, 23, 26-28, 31, and 33, it would have been obvious to one of ordinary skill in the art at the time of the invention to have configured the *Baum* partitions to be intersected, slotted and arranged in a matrix as taught by *Sherman* so as to provide a versatile design. Applicant disagrees with this rejection for the following reasons.

This combination is clearly unobvious and that it would have been unobvious to utilize the egg crate slotted partition cell structure of *Sherman* in the camera case of *Baum*. The partitions of *Baum* are adjustable and movable anywhere within the interior of the camera carrying case 23 so as to accommodate varying shapes and sizes of fragile cameras and lenses. The slotted pantyhose partition assembly of *Sherman* would have, in fact, destroyed the whole purpose of the partition assembly of *Baum*. Such a cell structure would not accommodate cameras and lenses of various sizes and configurations and would not have provided sufficient protection for those very delicate and fragile camera components.

Furthermore, there is no suggestion or teaching in the prior art of substituting slotted partitions formed into a multiple identical cell structure as disclosed in *Sherman* for the

partitions of *Baum*. Both of those patents disclose their respective partition assemblies for very specific different purposes, one for storing pantyhose in a dresser drawer where all the cells can be of the same size and shape and the other for storing cameras and camera components where variability and adjustability of the partitions within the container are the whole purpose of the partitions and reason for the existence of the partitions within the container. The Examiner's combination of prior art is clearly unobvious and lacking in any suggestion for combining the two reference structures.

In connection with the rejection of claims 2, 7, 10, 28 and 33, the Examiner refers in connection with the rejection of these claims that "*Baum* discloses the hook and loop fastener having a first component secured to the container walls (Fig. 4, the inner wall fabric), and a second component secured to a partition, as shown in Fig. 4, Item 32." The Item 32 is the Velcro® strips secured to the top or lid of the container. That Velcro® strip is not secured to a partition. While the Examiner repeats this statement in three different paragraphs, and in each refers to the Velcro® strip 32 as being secured to a partition, that appears to be a misnomer. He apparently intended to refer to the Velcro® hook straps 36, 37, 38 and 39 which are sewn to the sides of the partitions and extend at right angles to those partitions. These strips clearly do not form extensions of the partitions in the plane of the partitions so as to enable those partitions to accommodate varying size containers.

In rejecting all of the claims of this application, the Examiner has combined *Sherman* with *Baum*, either alone or in combination with other patents. Since this combination is improper for the reasons set forth hereinabove, it is submitted that the rejection of all of the claims of this application fails for these reasons. It is also submitted that *Baum* does not, in fact,

disclose hook and loop fasteners for securing a partition assembly within a container. *Baum* utilizes Velcro® strips having miniature hooks or burrs for securing partitions to the fabric covering of a container. That fabric covering is “a soft, fine, wool-like material to which the miniature hooks or burrs of pressure sensitive Velcro® strips will adhere”. Consequently, it is submitted that *Baum* does not disclose hook and loop fasteners as is called for by the claims of this application for securing a matrix of intersecting slot partitions to the walls of a container wherein one component of the hook loop fastener is secured to matrix of partitions and the other component is secured to the inside wall of the container.

The Examiner has not established a prima facie case of obviousness in his rejection of claims 1-3, 6-10, 12, 21, 23, 26-28, 31 and 33. The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument against the combination. *Id.* If examination does not produce a prima facie case of obviousness, then without more, the applicant is entitled to grant of the patent. *Id.* A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 782, 26 USPQ.2d 1529, 1531 (Fed. Cir. 1993).

In other words, to properly combine references to make a prima facie case of obviousness, case law requires that there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings

of the two references. *See e.g. ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984); *W. L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983); and *In re Dembiczaik*, 50 USPQ2d 1614, (Fed. Cir. 1999).

The rejection is further improper because the Examiner has simply used applicant's claims as a blueprint to abstract bits and pieces of the prior art together, through hindsight to make the § 103 rejection. It must be recognized that a combination of prior art is improper and not "obvious" if the only suggestion or reason for combining the teachings of the prior art is to be found in the present application. *In re Pye & Peterson*, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be combined does not make the combination "obvious" unless the art also contains something to suggest the desirability of the combination. *In re Rinehart*, 189 USPQ 143 (CCPA 1976); *In re Regel*, 188 USPQ 136 (CCPA 1975); *In re Avery*, 186 USPQ 161 (CCPA 1975); *In re Imperato*, 179 USPQ 730 (CCPA 1973); and *In re Andre*, 144 USPQ 497 (CCPA 1965).

It is submitted that the Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the cited pieces of prior art to create the combinations upon which he rejected the claims of the application. This was error as a matter of law. *W.L. Gore*, 220 USPQ at 312 (Fed. Cir. 1983).

The Examiner has impermissibly used hindsight to conclude that it would have been obvious to modify *Baum* in view of *Sherman* to yield the claimed combination. As discussed above, it is improper to use the claimed invention as a template for modifying a reference in order to render the invention obvious. As such, the Examiner has failed to make a

prima facie case of obviousness. Accordingly, claims 1-3, 6-10, 12, 21, 23, 26-28, 31 and 33 are patentable over *Baum* in view of *Sherman*.

Rejection of Claims 4, 5, 9, 11, 13, 22, 24, 25 and 29 Under 35 U.S.C. § 103(a)

Claims 4, 5, 9, 11, 13, 22, 24, 25 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Baum* in view of *Sherman* and further in view of *Cyr*. The Examiner states that *Baum* as modified discloses the claimed invention except for the second component being adhesively secured to the partition end. The Examiner contends that *Cyr* teaches a container with flexible partitions wherein the loop fasteners attached to the inner walls of the container are secured via adhesives, or sewing, equivalently, thereby providing an alternate means of connection. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the connection of *Baum*, of the second component to the partition via sewing, to be secured via adhesives therewith, as taught by *Cyr* so as to provide an alternate and equivalent means of connection. Applicant disagrees with this rejection for the following reasons.

Cyr discloses a camera carrying case wherein there are adjustable partitions contained within the case and secured within variable positions of adjustment by Velcro® fasteners attached to the inside surface of the camera case and to the partitions. The Examiner has relied upon the *Cyr* reference for its disclosure of the Velcro® strips 71 (see Figures 2 and 3) being attached to the inside fabric covered sidewalls 31 and 32 of the container by either adhesive or sewing (see column 6, lines 60-65). Wherein it is stated as:

Strips 71 may be attached by adhesives to inner fabric 34, but it is preferred to sew the strips to inner fabric 34 before the inner fabric is formed into its sandwich to make sidewalls 31 and 32.

It is submitted that the rejection of claims 4, 5, 9, 11, 13, 22, 24, 25 and 29 fail for the same reasons as set forth hereinabove relative to the rejection of claims 1, 10, 12, 21 and 28, respectively. That is, it would have been unobvious to utilize the slotted partition cell structure of *Sherman* in the *Baum* camera case. To have made this substitution would have destroyed the whole purpose of *Baum*, i.e., the ability to adjust and move the partitions anywhere within the interior of the camera carrying case so as to accommodate varying shapes and sizes of fragile cameras and lenses. The slotted panty hose partition assembly of *Sherman* would have in fact destroyed the whole purpose of the partition assembly of *Baum*. Such a cell structure would not accommodate cameras and lenses of various sizes and configurations and would not have provided sufficient protection for those very delicate fragile camera components. In making this rejection based upon the combination of *Baum*, *Sherman* and *Cyr*, the Examiner stated that:

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the connection of *Baum*, of the second component to the partition via sewing, to be secured via adhesives therewith, as taught by *Cyr* so as to provide an alternate equivalent means of connection.

In *Cyr* there is no component of the hook and loop fastener components adhesively secured to the partition; rather in *Cyr* the component 71 of the hook and loop fastener is secured to the inside wall of the container by adhesive, not to the partition. It is submitted that this is a distinct important difference because it is the adhesively secured components secured to the partition which facilitates adjustability of the length of the partition so as to enable variable

size partition assemblies to be contained within the inside of a container or variable size containers.

Even when combined the three references do not anticipate or meet all of the limitations of claims 4, 5, 9, 11, 13, 22, 24, 25 and 29.

The Examiner has not established a prima facie case of obviousness in this rejection. The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument against the combination. *Id.* If examination does not produce a prima facie case of obviousness, then without more, the applicant is entitled to grant of the patent. *Id.* A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 782, 26 USPQ.2d 1529, 1531 (Fed. Cir. 1993).

In other words, to properly combine references to make a prima facie case of obviousness, case law requires that there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings of the two references. *See e.g. ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984); *W. L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983); and *In re Dembiczaik*, 50 USPQ2d 1614, (Fed. Cir. 1999).

The rejection is further improper because the Examiner has simply used applicant's claims as a blueprint to abstract bits and pieces of the prior art together, through

hindsight to make the § 103 rejection. It must be recognized that a combination of prior art is improper and not “obvious” if the only suggestion or reason for combining the teachings of the prior art is to be found in the present application. *In re Pye & Peterson*, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be combined does not make the combination “obvious” unless the art also contains something to suggest the desirability of the combination. *In re Rinehart*, 189 USPQ 143 (CCPA 1976); *In re Regel*, 188 USPQ 136 (CCPA 1975); *In re Avery*, 186 USPQ 161 (CCPA 1975); *In re Imperato*, 179 USPQ 730 (CCPA 1973); and *In re Andre*, 144 USPQ 497 (CCPA 1965).

It is submitted that the Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the cited pieces of prior art to create the combinations upon which he rejected the claims of the application. This was error as a matter of law. *W.L. Gore*, 220 USPQ at 312 (Fed. Cir. 1983).

The Examiner has impermissibly used hindsight to conclude that it would have been obvious to modify *Baum* in view of *Sherman* and *Cyr* to yield the claimed combination. As discussed above, it is improper to use the claimed invention as a template for modifying a reference in order to render the invention obvious. As such, the Examiner has failed to make a *prima facie* case of obviousness.

Rejection of Claims 30 and 32 Under 35 U.S.C. § 103(a)

Claims 30 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Baum* in view of *Sherman* and further in view of *Cox*. The Examiner states that *Baum* as modified discloses the claimed invention except for the second component having an adhesive

removable backing. The Examiner contends that *Cox* discloses hook and loop fasteners with a release backing configuration. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the hook and loop fasteners of *Baum*, as modified by *Sherman*, to have a peel-back adhesive as taught by *Cox* so as to provide a convenient means of implementing the hook and loop fasteners. Applicant disagrees with this rejection for the following reasons.

It is submitted that the rejection of claims 30 and 32 fail for the same reasons as set forth hereinabove relative to the rejection of claim 28. That is, it would have been unobvious to utilize the slotted partition cell structure of *Sherman* in the *Baum* camera case. To have made this substitution would have destroyed the whole purpose of *Baum*, i.e., the ability to adjust and move the partitions anywhere within the interior of the camera carrying case so as to accommodate varying shapes and sizes of fragile cameras and lenses. The slotted panty hose partition assembly of *Sherman* would have in fact destroyed the whole purpose of the partition assembly of *Baum*. Such a cell structure would not accommodate cameras and lenses of various sizes and configurations and would not have provided sufficient protection for those very delicate fragile camera components.

Cox discloses a shoulder rest for use in combination with a telephone head set wherein the telephone is secured to the headrest by Velcro® fasteners. The Examiner relied upon this *Cox* patent for its disclosure of hook and loop fasteners having a release backing over the adhesive backing on the hook and loop fasteners 18 and 20, respectively, one of which is to be attached to the shoulder rest and the other to be attached to the portable phone (see Figure 8 and column 2, lines 47-54 of the '606 patent).

Again, the Examiner has not established a *prima facie* case of obviousness in this rejection. The Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument against the combination. *Id.* If examination does not produce a *prima facie* case of obviousness, then without more, the applicant is entitled to grant of the patent. *Id.* A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 782, 26 USPQ.2d 1529, 1531 (Fed. Cir. 1993).

In other words, to properly combine references to make a *prima facie* case of obviousness, case law requires that there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings of the two references. *See e.g. ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984); *W. L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983); and *In re Dembiczaik*, 50 USPQ2d 1614, (Fed. Cir. 1999).

The rejection is further improper because the Examiner has simply used applicant's claims as a blueprint to abstract bits and pieces of the prior art together, through hindsight to make the § 103 rejection. It must be recognized that a combination of prior art is improper and not "obvious" if the only suggestion or reason for combining the teachings of the prior art is to be found in the present application. *In re Pye & Peterson*, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be

combined does not make the combination “obvious” unless the art also contains something to suggest the desirability of the combination. *In re Rinehart*, 189 USPQ 143 (CCPA 1976); *In re Regel*, 188 USPQ 136 (CCPA 1975); *In re Avery*, 186 USPQ 161 (CCPA 1975); *In re Imperato*, 179 USPQ 730 (CCPA 1973); and *In re Andre*, 144 USPQ 497 (CCPA 1965).

It is submitted that the Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the cited pieces of prior art to create the combinations upon which he rejected the claims of the application. This was error as a matter of law. *W.L. Gore*, 220 USPQ at 312 (Fed. Cir. 1983).

The Examiner has impermissibly used hindsight to conclude that it would have been obvious to modify *Baum* in view of *Sherman* and *Cox* to yield the claimed combination. As discussed above, it is improper to use the claimed invention as a template for modifying a reference in order to render the invention obvious. As such, the Examiner has failed to make a *prima facie* case of obviousness. Even when combined the three references do not anticipate or meet all of the limitations of claims 30 and 32.

VIII. CONCLUSION

In conclusion, applicants respectfully request that the Board reverse the Examiner's rejections of claims 1-13 and 21-33 and that the application be passed to issue. If there are any questions regarding the foregoing, please contact the undersigned at 513-241-2324.

Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

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IX. CLAIMS APPENDIX: CLAIMS ON APPEAL (S/N 10/629,726)

- 1.(Previously Presented) A combination comprising:
 - a partition assembly including intersecting slotted partitions arranged in a matrix,
 - a container having walls extending upwardly from a bottom, said bottom and said walls of said container defining an interior of said container;
 - said partitions being of a length such that said partition assembly may fit in said interior of said container without bending said partitions;
 - wherein said partition assembly is held in said interior of said container by at least one hook and loop fastener.
- 2.(Original) The combination of claim 1 wherein said hook and loop fastener comprises a first component secured to an inner surface of one of said container walls and a second component secured to one of said partitions.
- 3.(Original) The combination of claim 2 wherein one of said components has hooks engaged with loops on the other of said components.
- 4.(Original) The combination of claim 2 wherein said second component is adhesively secured to said one of said partitions.

5.(Original) The combination of claim 2 wherein said second component of said hook and loop fastener is a piece of fabric adhesively secured to opposite side surfaces of said one of said partitions.

6.(Original) The combination of claim 2 wherein said second component of said hook and loop fastener functions as a flexible extension of said one of said partitions.

7.(Previously Presented) The combination of claim 2 wherein said second component of said hook and loop fastener has an exterior surface which has a plurality of loops.

8.(Original) The combination of claim 2 wherein said second component of said hook and loop fastener is a flexible tab.

9.(Original) The combination of claim 1 wherein said partitions are plastic.

10.(Previously Presented) A combination comprising:
a container;
a partition assembly for dividing space inside the container, said container having a plurality of walls, one component of a two part hook and loop fastener being secured to an inner surface of one of said walls of said container, said partition assembly comprising:
a plurality of first slotted partitions;
a plurality of second slotted partitions;

said first and second slotted partitions being arranged in a matrix;
 one of said slotted partitions having a flexible tab at the end thereof, said flexible tab
 comprising a second component of said two part hook and loop fastener adapted for engagement
 with said first component of said two part hook and loop fastener without bending any of said
 partitions, wherein said tab may be bent to either side of said one of said slotted partitions to
 engage said first component of said two part hook and loop fastener.

11.(Previously Presented) The combination of claim 10 wherein each of said partitions is
 plastic.

12.(Previously Presented) A combination comprising:
 a container;
 a partition assembly for insertion into said container, said container having walls
 extending upwardly from a bottom, said bottom and walls defining an interior of said container,
 the linear distance between inner surfaces of two opposed walls of said container defining a
 width of an interior of said container and the distance between inner surfaces of the other two
 opposed walls of said container defining a length of said interior of said container, one
 component of a two part hook and loop fastener being secured to an inner surface of one of said
 walls of said container, said partition assembly comprising:

 a plurality of first slotted partitions, each first slotted partition having a series of slots
 extending inwardly from an edge thereof;

a plurality of second slotted partitions, each second slotted partition having a series of slots extending inwardly from an edge thereof;

 said first and second slotted partitions being arranged in a matrix, one of said slots of a first slotted partition being engaged with one of said slots of a second slotted partition at an intersection;

 each of said first slotted partitions being shorter than said width of said interior of said container and each of said second slotted partition being shorter than said length of said container;

 one of said slotted partitions having a flexible tab at the end thereof, said flexible tab comprising a second component of said two part hook and loop fastener for engagement with said first component of said two part hook and loop fastener on either side of said one of said slotted partitions.

13.(Previously Presented) The combination of claim 12 wherein each of said partitions is plastic.

14.(Cancelled).

15.(Cancelled).

16.(Cancelled).

17.(Cancelled).

18.(Cancelled).

19.(Cancelled).

20.(Cancelled).

21. (Previously Presented) A combination comprising:

 a container having walls extending upwardly from a bottom, said bottom and said walls of said container defining an interior of said container;

 a partition assembly including slotted partitions arranged in a matrix, said partitions being of a length such that said partition assembly may fit in said interior of said container without bending said partitions;

 wherein said partition assembly is held in said interior of said container by at least one hook and loop fastener comprising a first component secured to an inner surface of one of said container walls and a second flexible component secured to one of said partitions, said second flexible component being adapted to bend both clockwise and counterclockwise relative to said one of said partitions.

22. (Previously Presented) The combination of claim 21 wherein said partitions are plastic.

23. (Previously Presented) The combination of claim 21 wherein one of said components has hooks engaged with loops on the other of said components.

24. (Previously Presented) The combination of claim 21 wherein said second component is adhesively secured to said one of said partitions.

25. (Previously Presented) The combination of claim 21 wherein said second component of said hook and loop fastener is a piece of fabric adhesively secured to opposite side surfaces of said one of said partitions.

26. (Previously Presented) The combination of claim 21 wherein said second component of said hook and loop fastener functions as a generally planar extension of said one of said partitions.

27. (Previously Presented) The combination of claim 21 wherein said second component of said hook and loop fastener has an exterior surface which has a plurality of loops.

28. (Previously Presented) A combination comprising:
a container having walls extending upwardly from a bottom, said bottom and side walls defining an interior of the container;
a partition assembly for dividing the interior of the container, one component of a two part hook and loop fastener being secured to an inner surface of one of the walls of the container, the partition assembly comprising:

a plurality of first and second slotted partitions arranged in a matrix; one of the slotted partitions having a flexible tab sandwiched around the end thereof, said flexible tab comprising a second component of the two part hook and loop fastener adapted for engagement with the first component of the two part hook and loop fastener without bending any of the partitions.

29. (Previously Presented) The combination of claim 28 wherein each of said partitions is plastic.

30. (Previously Presented) The combination of claim 28 wherein each of said second component of said two part hook and loop fastener has a removable backing covering an adhesive surface, said adhesive surface adapted to attach to said ends of said slotted partitions.

31. (Previously Presented) The combination of claim 28 wherein each of said second component of said two part hook and loop fastener is adapted to planarly extend said partition.

32. (Previously Presented) The combination of claim 28 wherein said one component of a two part hook and loop fastener has a removable backing covering an adhesive surface, said adhesive surface being secured to an inner surface of one of said walls of said container.

33. (Previously Presented) A combination comprising

a container having walls extending upwardly from a bottom, said bottom and side walls defining an interior of the container, one component of a two part hook and loop fastener being secured to an inner surface of one of said walls of said container;

a partition assembly comprising:

a plurality of first slotted partitions, each first slotted partition having a series of slots extending inwardly from an edge thereof;

a plurality of second slotted partitions, each second slotted partition having a series of slots extending inwardly from an edge thereof;

said first and second slotted partitions being arranged in a matrix, one of said slots of a first slotted partition being engaged with one of said slots of a second slotted partition at an intersection;

one of said slotted partitions having a flexible tab sandwiched around the end thereof, said flexible tab comprising a second component of said two part hook and loop fastener for engagement with said first component of said two part hook and loop fastener.

IX. EVIDENCE APPENDIX: (S/N 10/629,726)

Appellant relies on no additional evidence.

X. RELATED PROCEEDINGS APPENDIX: (S/N 10/629,726)

None